REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on October 25, 2002, and the references cited therewith. Applicant has amended claim 22 such that claims 1-30 are now pending in this application.

Allowable Subject Matter

Applicant notes with appreciation that claims 5, 15 and 24 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

§103 Rejections of the Claims

Lagoni, Isaka and Goldwasser et al.

Claims 1-3, 12, 13, 20, 21, 22, 27-30 were rejected under 35 USC § 103(a) as being unpatentable over Lagoni et al. (US 6,141,058) in view of Isaka (US 5,706,388) and Goldwasser et al. (US 5,241,428). In order to establish a prima facie case of obviousness, the references must teach or suggest all the claim elements. See M.P.E.P. § 2142 and *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

The Examiner acknowledges that Lagoni does not each or suggest all of the elements in claims 1, 12, 13, 20-22 by stating at page 3 of the Office Action that "Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program."

The Examiner attempts to overcome the deficiencies of Lagoni by combining Lagoni with Isaka and Goldwasser. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). According to the Office Action:

> "[i]t would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system." Page 4, Office Action.

Applicant traverses the assertion as it fails to explain how Lagoni would be modified to include the recording/reproducing system of Isaka. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

In addition, Applicant respectfully submits that the Examiner's statement regarding a motivation to combine Lagoni with Isaka and Goldwasser is conclusory because the Examiner's statements are analogous to those made by the Examiner and Board in the recently decided case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

> "With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentablility, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use '[use] that which the inventor taught against its teacher.' *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." *Lee,* at 1343, 1344.

Applicant can not find any teaching or suggestion in Lagoni relating to

recording program data. In addition, there is no teaching or suggestion in Isaka related to displaying caller data as part of the reproducing/recording system.

The Examiner impermissibly uses the current invention as a roadmap to make the combination of Lagoni with Isaka and Goldwasser. Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references and the rejection should be withdrawn.

Applicant respectfully requests that the Examiner provide some prior art that teaches or suggests utilizing and/or displaying caller identification information upon receipt of the call in combination with:

(i) "a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 1;

(ii) "means for buffering the real-time program from the acceptance of the call and providing the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" as recited in claim 12;

(iii) "buffering the real-time program from the acceptance of the call" as recited in claim 20; and

(iv) "in the event said detecting means detects an incoming phone call, said recording means being capable of recording the video input signal during the phone call, and said displaying means being capable of displaying the recorded video input signal to a user upon termination of the phone call" as recited in claim 22.

There is also no teaching or suggestion anywhere in Goldwasser that the disclosed variable-delay video recorder is operationally related to a phone, phone call and/or phone system. The system in Goldwasser is entirely user-operated. Each description in Goldwasser that relates to phones or phone calls is done to provide an example reason as to why a user may activate the variable-delay video recorder.

Reconsideration and allowance of claims 1-3, 12, 13, 20, 21, 22, 27-30 are respectfully

requested.

Lagoni, Goldwasser and Natori

Claims 4, 6-9, 14, 16-19 were rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP 02001028645A). The Examiner's only statements relating to a motivation to combine Natori with Lagoni and Goldwasser are at page 5 of the Office Action:

> "Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for storing length of call as this arrangement would provide call history for the user for referencing it when required as taught by Natori."

Applicant respectfully traverses the assertion because as acknowledged by the Examiner at page 5 of the Office Action, there is no teaching or suggestion in Lagoni, Isaka and Goldwasser relating to storing data about the length of a call. The Examiner impermissibly uses the current invention as a roadmap to make the combination of Natori with Lagoni, Isaka and Goldwasser. Furthermore, Applicant respectfully submits that the Examiner's statement regarding motivation is conclusory because the Examiner's statements are again analogous to those made by the Examiner and Board in the recently decided case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

There is no teaching or suggestion in Natori relating to caller identification or buffering programs such that Applicant can not see how one of ordinary skill in the art would look to combine Natori with Lagoni, Isaka and Goldwasser. Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references and the rejection should be withdrawn.

Reconsideration and allowance of claims 4, 6-9, 14, 16-19 are respectfully requested.

Lagoni, Goldwasser and Tsutsumi

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP

406319173A). The Examiner states at page 6 of the Office Action:

> "Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user as this arrangement would enable the user to answer the call without going to the place of handset by using the remote controller as taught by Tsutsumi."

Applicant respectfully submits that the Examiner's statement regarding motivation to combine the references is again conclusory (*See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). There is no teaching or suggestion in Tsutsumi relating to caller identification or buffering programs, and Lagoni, Isaka and Goldwasser provide no suggestion of using a telephone handset as a remote control.

Applicant can not find any disclosure in these references that would lead one of ordinary skill in the art to combine Tsutsumi with Lagoni, Isaka and Goldwasser. If the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

Reconsideration and allowance of claim 10 are respectfully requested.

Lagoni, Goldwasser and Lund

Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Lund (US 6,342,270 B1, filed 7/13/1998). The Examiner's only statements relating to a motivation to combine Lund with Lagoni and Goldwasser are at page 7 of the Office Action:

> "Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user as this would enable the user to answer the telephone call without being distracted by television audio as taught by Lund."

This is a mere conclusory statement of subjective belief. The Examiner is impermissibly using the current invention as a roadmap to make the combination. There is no teaching or

suggestion in Lund relating to buffering programs, and Goldwasser provides no teaching suggestion as to operationally integrating caller ID into a system of electronic devices. In addition, there is no disclosure in Lund relating to displaying caller identification information on a television upon receipt of a call.

Therefore, Applicant can not find any teaching or suggestion in any of the references that would lead one of ordinary skill in the art to combine Lund with Lagoni, Isaka and Goldwasser. Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references and the rejection should be withdrawn.

Reconsideration and allowance of claim 11 are respectfully requested.

Lagoni, Isaka, Goldwasser, Shimada et al. and Tamura et al

Claims 25-26 were rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP 403178247A) and Tamura et al. (JP 404112374A). The Examiner states at pages 7 and 8 of the Office Action:

> "Thus, it would have been obvious to one of skill in the art at the time invention was made to modify the combination to provide for the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call as this arrangement would facilitate to record messages when user is unable to answer the call as taught by Shimada; voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means as this arrangement would facilitate storage facilities for messages at different locations to suite users requirements when the user is unable to answer the call as taught by Shimada and Tamura."

Applicant traverses the assertion as it fails to explain how Lagoni, Isaka and/or Goldwasser would be modified by either Shimada or Tamura much less the combination of Shimada and Tamura. Applicant is unsure how the systems disclosed in Shimada and Tamura could be combined into the systems disclosed in Lagoni, Isaka and/or Goldwasser. It is respectfully submitted that the assertion amounts to a form of Official Notice, which is timely

traversed under MPEP 2144.03, and if the Examiner is aware of a patent providing support of the assertion, citation of the patent is respectfully requested.

Furthermore, Applicant respectfully submits that the Examiner's statement regarding motivation to combine is similarly conclusory (See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). There is no teaching or suggestion in Shimada and/or Tamura relating to either buffering programs or incorporating caller ID. In addition, Applicant can not find any disclosure in Lagoni, Isaka and/or Goldwasser relating to including a voicemail system.

Reconsideration and allowance of claims 25 and 26 are respectfully requested.

Lagoni, Isaka Goldwasser and Schultheiss et al.

Claim 23 was rejected under 35 USC § 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831). The Examiner's only statements relating to a motivation to combine Schultheiss with Lagoni, Isaka and Goldwasser are at page 8 of the Office Action:

> "Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: recording means comprises a structure selected from the group consisting of: set to box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television as this arrangement would provide varied structure to control and record information as taught by Schultheiss, thus enhancing the usefulness of the system."

Applicant respectfully submits that the Examiner's statement regarding motivation to combine is again conclusory (*See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). There is no teaching or suggestion in Schultheiss relating to caller identification or buffering programs. In addition, Applicant can not find any teaching or suggestion in Lagoni, Isaka and Goldwasser relating to systems for providing television related services via a networked personal computer. If the Examiner is aware of a patent that provides such teaching or suggestion, citation of the patent is respectfully requested.

Reconsideration and allowance of claim 23 are respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 9 day of January, 2003.

Candis B. Buending
Name

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Signature